

REMARKS

Claims 3, 4, 9-20, 22 and 26-34 were pending in this application.

Claims 23-25 were previously withdrawn from further consideration by the Examiner pursuant to 37 C.F.R. § 1.142(b) as being drawn to non-elected inventions, and were canceled without prejudice in the Amendment After Final.

Claim 22 was also canceled without prejudice in the Amendment After Final.

In the Amendment After Final, amendments were made to claims 3, 4, and 14 to more particularly point out and distinctly define the invention, and new claims 35-40 were added to further define the invention. Support for these amendments and new claims found throughout the specification and examples as filed were also explained. No new matter is contained either in the amendments or the new claims.

Accordingly, reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the further remarks made herein.

I. Finality Of Rejection Is Improper And Should Be Reversed.

Applicants respectfully submit that the finality of the Office Action mailed May 30, 2003 is improper because there were new rejections of claim 9 set forth in the Final Office Action that were not previously set forth by the Examiner and were not necessitated by amendments to the claims.

The Examiner asserts that “the scope of claim 9 has changed because it depends on claim 3 whose scope has been narrowed.” (Advisory Action, p. 3, ¶ 6).

Applicants respectfully disagree. While Applicants have amended claim 3 to better describe chemical properties of the genus of chemical compounds which Applicants consider to be their invention, claim 9 describes a particular specific compound by its structural chemical formula. Thus, the amendment to claim 3 did not alter the scope of claim 9 in any way, since the structure of the specific compound set forth in claim 9 was not changed in any way.

Furthermore, the Examiner argues that even if the scope of claim 9 is not changed, finality would still be proper “because the new reference(s) were found as a result of Applicants’ amendments to their generic claim, which is in compliance with MPEP 706.07(a).” (Advisory Action, p. 3, ¶ 6).

Applicants urge that this proposition is not supported by the MPEP:

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings **will not be made final if it includes a rejection, on newly cited art**, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), **of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.**

MPEP § 706.07(a) (emphasis added).

Therefore, the assertion of a newly cited art, Knight et al. (1996) at Paragraph 37 of the Final Office Action against Applicants’ unamended claim 9 indicates that the finality of the Office Action is improper since this was not necessitated by Applicants’ amendments. Therefore, Applicants urge that the finality of the Office Action should be withdrawn.

Furthermore, Applicants again respectfully submit that a clearly defined issue between the applicant and Examiner should be reached prior to the issuance of a final office action:

Before final rejection is in order a clear issue should be developed between the examiner and applicant....the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application **or a final rejection**...

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and **that a clear issue between applicant and examiner should be developed**, if possible, before appeal.

(MPEP §706.07, emphasis added).

Thus, Applicants believe it is improper to make an office action final when Applicants did not have a chance to distinguish the newly cited art from the disclosure in the subject specification and to fully rebut the Examiner’s arguments. Furthermore, throughout the Office Action, the Examiner reads the following limitation of the co-reactant recited in claims 3 and 4 — “coreactant undergoes oxidation

to form a reductant or reduction to form an oxidant” — as a statement of intended use instead of a limitation that excludes compounds that cannot undergo this transformation. This objection may have been caused by an apparent misunderstanding of the claimed technology and further evidences that Applicants did not have an opportunity to develop a clear issue between Applicants and Examiner prior to issuance of the Final Office Action.

Therefore, Applicants respectfully request the finality of the Office Action be removed.

II. Applicants’ Amendment Should Be Entered.

Applicants respectfully submit that the non-entry of the Amendment filed November 26, 2003 is improper. In the Advisory Action, the Examiner argues:

Claims 3-4 and 14...inserts new claim limitations (e.g., claim 3 no longer requires that the coreactant ‘undergoes’ oxidation or reduction, but only that it “can” undergo said oxidation or reduction...), which introduces the issue of new matter and/or additional search and consideration.

(Advisory Action, p. 2, ¶ 4).

In the Amendment After Final, Applicants amended independent claim 3, for example, by replacing:

“A compound...wherein said coreactant undergoes oxidation to form a reductant or reduction to form an oxidant, such that said compound emits electrochemiluminescence when exposed to electrochemical energy”

With:

“Wherein:

- (i) said coreactant can be oxidized to form a reductant or reduced to form an oxidant; and
- (ii) on exposure of said compound to electrochemical energy sufficient to form said reductant or said oxidant, said reductant or oxidant reacts with said label so as to cause said label to emit electrochemiluminescence.”

It is unclear what the basis is for the Examiner’s non-entry of the amendment. Contrary to the Examiner’s assertions, Applicants’ amendment of a compound claim to recite “wherein...the coreactant can be oxidized” in place of “wherein the coreactant undergoes oxidation...” does not introduce the

issue of new matter since the amendment claim is fully supported by the specification. Moreover, the amendment does not require additional search and consideration since does not materially change the scope of the compound claim.

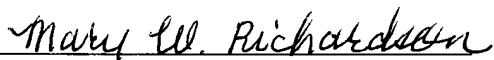
Accordingly, Applicants request that the amendment be entered and properly considered by the Examiner.

II. Conclusion

In view of the remarks submitted herein, reconsideration and withdrawal of the rejections to Claims 3, 4, 9-20, and 26-34 pending in this application is earnestly solicited, together with favorable consideration of new Claims 35-40, and prompt issuance of a Notice of Allowance.

Applicants submit that the instant application is in condition for allowance, the early notification of which is respectfully requested.

Respectfully submitted,



Barry Evans, Esq. (Reg. No. 22,802)

Mary W. Richardson, Esq. (Reg. No. 48,320)

KRAMER LEVIN NAFTALIS & FRANKEL LLP

919 Third Avenue

New York, New York 10022

Tel: (212) 715-9100

Fax: (212) 715-8000

Attorneys for Applicants